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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,143	11/10/2000	William C. Tate	81803F-P	3253

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PATENT LEGAL STAFF
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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,143

Applicant(s)

TATE, WILLIAM C.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 and 11 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 4. 6) ☐ Other: _____

DETAILED ACTION

Applicant's "Preliminary Amendment" deposited on June 11, 2001 has been considered.

Drawings

The drawings filed on November 10, 2000 and June 11, 2001 are acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 18-26 and 28-29 rejected under 35 U.S.C. 102(e) as being anticipated by Jebens. Regarding claims 14-15 and 28-29, Jebens discloses a method, computer software product, and system for ordering goods and/or services with respect to digital images comprising:

- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- the email having a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);

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- the email having a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site only upon opening of the email at the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- the static text/and/or graphics containing an order section for ordering of goods and/or services with respect to the dynamic data (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- dynamic data comprises the low-resolution digital image file (col. 8, lines 12-18); and
- a fulfillment provider for filling of the order, the email having information for allowing the automatic forwarding of the order to the fulfillment provider (col. 22, lines 24-92; col. 23, lines 3-18)

Regarding claims 16 and 26, Jebens discloses the static text and/or graphic comprises an order form for placement of an order for goods and/or services with respect to the image (col. 21, lines 62-66; Figure 10F); and Internet (col. 6, lines 1-5).

Regarding claims 18-19 and 21, Jebens discloses the email further includes a URL address of a second party which, upon placing of an order using the order section, will be used to send said order automatically to the second party, the URL address being different from the URL address of the first party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); the second party will fulfill the order placed by the customer (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); and a notice is sent to the first party by the second party when the order is placed with

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the second party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66).

Regarding claims 20 and 22, Jebens discloses a portion of the money paid by the customer to the second party is allocated to the first party; and the portion of the money paid to the second party is forwarded to the first party upon or after receipt of payment by the customer to the second party. (Col. 17, line 51 – col. 18, line 27)

Regarding claims 23-25, Jebens discloses the email includes the ability for the customer to send an e-mail to a third party for allowing access to the images at the server and for placement of an order by the third party; the customer further permits the third party to provide additional data to the images; and the server allows the third party to provide data the dynamic data (col. 3, lines 1-10; col. 3, lines 51-65; col. 14, lines 11-54; Claim 35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 17, 27, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,321,231 to Jebens et al. and further in view of U.S. Patent No. 6,388,732 to Williams et al.

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Regarding claims 1-2, 4, and 27, Jebens discloses a method and computer software product for ordering goods and/or services with respect to digital images comprising:

- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I); and
- dynamic data comprises the low-resolution digital image file (col. 8, lines 12-18).

However, Jebens does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include

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the emailing of the images and the location, as taught by Williams, in order to provide photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claims 3 and 13 (which depends on claim 1), Jebens discloses the static text and/or graphic comprises an order form for placement of an order for goods and/or services with respect to the image (col. 21, lines 62-66; Figure 10F); and Internet (col. 6, lines 1-5).

Regarding claims 5-6 and 8 (which depends on claim 1), Jebens discloses the email further includes a URL address of a second party which, upon placing of an order using the order section, will be used to send said order automatically to the second party, the URL address being different from the URL address of the first party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); the second party will fulfill the order placed by the customer (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); and a notice is sent to the first party by the second party when the order is placed with the second party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66).

Regarding claims 7 and 9 (which depend on claim 1), Jebens discloses a portion of the money paid by the customer to the second party is allocated to the first party; and the portion of the money paid to the second party is forwarded to the first party upon or after receipt of payment by the customer to the second party. (Col. 17, line 51 – col. 18, line 27)

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Regarding claims 10-12 (which depend on claim 1), Jebens the email includes the ability for the customer to send an e-mail to a third party for allowing access to the images at the server and for placement of an order by the third party; the customer further permits the third party to provide additional data to the images; and the server allows the third party to provide data to the dynamic data (col. 3, lines 1-10; col. 3, lines 51-65; col. 14, lines 11-54; Claim 35).

Regarding claim 17, Jebens substantially discloses the claimed invention, however, it does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include the emailing of the images and the location, as taught by Williams, in order to provide photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claim 30, Jebens discloses a system for ordering goods and/or services with respect to digital images comprising:

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- a retailer (image providers) for receiving an image product (col. 6, lines 55-60);
- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I); and
- a fulfillment provider, for filling the order, the email having information for allowing the automatic forwarding of the order to the fulfillment.

However, Jebens does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include the emailing of the images and the location, as taught by Williams, in order to provide

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photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claims 31-33, Jebens disclose the server is remote from the retailer (Figures 1-2; col. 6, lines 52 – col. 7, line 20); the fulfillment provider is remote from the retailer (Figures 1-2; col. 6, lines 52 – col. 7, line 20); and the fulfillment provider is remote from the server (Figures 1-2; col. 6, lines 52 – col. 7, line 20).

Regarding claims 34-36, Jebens discloses the fulfillment provider pays the retailer a portion of payment received from the customer for the order; the fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which of the plurality retailers forwards which of the orders to the fulfillment provider; and keeping track when the customer pays the fulfillment provider hand forwarding a portion of payment received from the customer to the retailer that sent the order to the fulfillment provider (col. 17, line 51 – col. 18, line 28).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

European Patent Application No. 0 860 985 A2 to Mochizuki discloses a data commutation apparatus and method for effectively communication image data.

U.S. Patent No. 6,167,382 to Sparks discloses a design and production system using an Internet site for the storage of pre-designed formats and images, the assembly of them into electronic files ready for production, and the ordering of all design, assembly, production, and distribution from a single entry point.

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U.S. Patent No. 6,229,884 to Toyoda et al. discloses an electronic mail system connected to a network which includes a section for converting an image of a document surface into corresponding document image data.

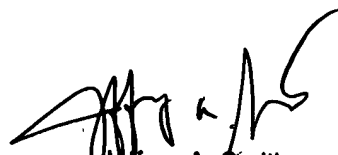
U.S. Patent No. 6,017,157 to Garfinkle et al. discloses a method of processing digital images of a photographic image and distributing the visual prints produced from the digital images in various formats corresponding to a digital image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Mtot
September 28, 2003



Jeffrey A. Smith
Primary Examiner